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In re Application of	:	
KOLBECK et al.	:	
U.S. Application No. 09/926,792	:	DECISION ON PETITION
PCT No.: PCT/EP00/05795	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 23 June 2000	:	
Priority Date: 25 June 1999	:	
Atty. Docket No.: KOLB3002/JEK	:	
For: METHOD FOR OPERATING A	:	
PORTABLE DATA CARRIER	:	
CONFIGURED FOR EXECUTING	:	
RELOADABLE FUNCTIONAL	:	
PROGRAMS	:	

This is a decision on applicants' "Petition under 37 CFR 1.47(a) and 1.497(b)(2)" filed 29 July 2002 to accept the application without the signature of joint inventor, Alexander Kolbeck. The required petition fee of \$130.00 (37 CFR 1.17(i)) has been submitted.

### **BACKGROUND**

On 23 June 2000, applicants filed international application PCT/EP00/05795 which claimed a priority date of 25 June 1999 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 04 January 2001. A Demand for international preliminary examination was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States was midnight, 26 December 2001 (25 December 2001 was a holiday).

On 20 December 2001, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); the international application; and a preliminary amendment.

On 01 February 2002, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 29 July 2002, applicants filed the present petition under 37 CFR 1.47(a) and a five-month extension of time.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1) and (3) have been satisfied.

As to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of its refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application paper should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

A review of the present petition reveals that applicant has not satisfied the item (2) above, in that the applicants have not shown that a *bona fide* attempt was made to present the application papers, including the specification, claims, and drawings to Alexander Kolbeck. Petitioner states that representatives of Giesecke & Devrient attempted to obtain the signature of Mr. Kolbeck on numerous dates. However, the petition fails to state what application papers were sent to the missing inventor. Was a complete application

(specification, claims, and drawings) mailed to the missing inventor? Additionally, no documentary evidence to support the failed attempts were provided in the petition. Furthermore, it does not appear that the petitioner has first hand knowledge of all the facts.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Alexander Kolbeck and when such papers were sent and that Alexander Kolbeck has subsequently refused to execute the application. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

As to item(4), the declarations filed 29 July 2002 are defective pursuant to 37 CFR 1.497(a)(3) which requires the declaration to identify each inventor and the country of citizenship of each inventor. Here, the declaration executed by the inventors does not contain a complete listing of all inventors. Therefore, the declarations are defective pursuant to 37 CFR 1.497. (See Section 201.03 of the Manual of Patent Examining Procedure (MPEP)).

For the reasons stated above, it would not be appropriate to accept the application without the signature of Alexander Kolbeck under 37 CFR 1.47(a) at this time.

### CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



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